

being directed to a non-elected invention. Applicants continue to traverse the Restriction Requirement for the reasons already of record.

The specification and claims 38, 39, 40, 129, 130, 131, 185, 219, 251, 279, 280, and 281 have been amended to correct minor typographical, grammatical, and/or claim dependency errors. Claim 214 has been amended to delete the acronym "PDMS." Support for these amendments can be found throughout the specification and claims as filed.

As discussed at the Interview of January 14, 2003, claims 1, 92, 185, 218-230, and 282 have been amended to recite that the at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature. Support for these amendments can be found at page 25, lines 9-11.

Accordingly, amendments made herein in no way narrow the scope of the amended claims, nor do they add new matter.

## II. Rejoinder of Claims

As discussed in the Interview with the Examiner and her supervisor, Applicants respectfully request reconsideration of previously restricted claims 1-91, 231-234, 243-244, 249, 252, 254, 255, 260, 261, 264, and 265 in view of the amendments made herein to the independent claims. Mr. Page graciously indicated that he would favorably reconsider rejoining the claims of Groups I and II provided the claims are amended to recite that the at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature. As Applicants have amended the claims in the manner suggested by the PTO to facilitate the PTO's offer of rejoinder,

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Applicants respectfully request that the claims of Group I be rejoined with the claims of Group II.

**III. Allowed Claims**

Applicants thank the Examiner for the indication that claims 266 and 267 are allowed. Although page 5 of the Office Action recites that “[c]laims 264-267 are allowed,” the telephone conference of August 22, 2002, between the Examiner and Jill MacAlpine clarified that claims 264 and 265 have been withdrawn from consideration based on Applicants’ election of the claims of Group II in the Response to Restriction Requirement filed April 15, 2002.

**IV. Rejection under 35 U.S.C. § 112, second paragraph**

a. “Chosen from”

Claims 93, 97, 98, 113, 114, 118, 120, 145, 146, 148, 158, 161, 162, 177, 179, 184, 186, 189, 190, 193, 200, 202, 207, 210, and 211 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that the words “chosen from” constitutes “improper Markush language.” See page 2 of the present Office Action. The Examiner states that “[p]roper Markush language is ‘selected from the group consisting of.’” *Id.* Applicants disagree, and respectfully traverse this rejection at least because the phrase is not indefinite and because Applicants have used language that is a proper alternative to Markush

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language. To that end, Applicants first address the indefiniteness issue, then address the Markush language issue.

Although the Examiner appears to allege that "chosen from" language is indefinite, the argument is not supported with an explanation of why this language is indefinite. The primary purpose of the requirement of definiteness is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what Applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. § 112 with respect to the claimed invention. M.P.E.P. § 2173 (7<sup>th</sup> ed. 1998).

Applicants submit that the public is clearly informed of the boundaries of infringement of a patent resulting from these claims as they stand. Applicants have merely claimed groups of elements to go into a composition, where elements from each group can be chosen as indicated in the claims - a perfectly allowable construction allowed by M.P.E.P. § 2173.05(h). A potential infringer would have no problem determining the elements of the claimed compositions to avoid infringement.

Further, Applicants assert that they are not using Markush language. Rather, Applicants are clearly claiming elements using different words. Put more simply, the phrase "X chosen from A, B, and C" is proper language and more accurately describes the claimed invention, *i.e.*, the composition contains at least one X that is independently chosen from the group A, B, and C. For example, both Applicants' claim language and the Examiner's proposed change cover a composition of the invention that contains: A;

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A and B; or two A's; two B's; A, B and C; as well as all other permutations and combinations of A, B, and C. Applicants' claim language is clear, and the Examiner has shown no legal basis for requiring the Applicants to change it, as there is no legal authority prohibiting the use of "chosen" rather than "selected." Accordingly, Applicants respectfully submit that this rejection under 35 U.S.C. § 112, second paragraph, is in error and respectfully request that the rejection be withdrawn.

"PDMS"

Claim 214 has been amended to delete the acronym "PDMS." Accordingly, this rejection has been rendered moot and Applicants respectfully request its withdrawal.

"Including"

Claim 225 has been rejected because, according to the Examiner, "the word 'including' is indefinite, because it is not established that there is a specific requirement in the claim or that it is only exemplary." See page 2 of the present Office Action. Applicants disagree.

The word "including" in claim 225 denotes the action to be taken to perform the claimed method, i.e., the method comprises the step of *including* the at least one liquid fatty phase in the composition. Accordingly, Applicants respectfully request withdrawal of this rejection.

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Antecedent basis in claims 279-281

Claims 279-281 have been amended to delete the word "anhydrous."

Accordingly, this rejection has been rendered moot and Applicants respectfully request its withdrawal.

**V. Rejection under 35 U.S.C. § 102**

Claims 92-99, 103, 106-136, 143-148, 158, 171, 177, 178, 179, 181, 182-195, 199-202, 204-212, 218-230, and 248 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,783,657 ("*Pavlin*"). See pages 3-4 of the present Office Action.<sup>1</sup> Applicants disagree and respectfully traverse this rejection.

As the Examiner and her supervisor agreed at the Interview on January 14, 2003, *Pavlin* fails to teach or suggest the at least one pasty fatty substance of the present invention. Because a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, *Pavlin* fails to anticipate the claims of the present application.

Nevertheless, in order to facilitate prosecution, and responsive to the Examiner's suggestion, claims 1, 92, 185, 218-230, and 282 have been amended to recite that the at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

Accordingly, Applicants respectfully request that the rejection under § 102(b) be withdrawn.

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<sup>1</sup> Applicants thank the Examiner for the clarification that the above-cited claims are the ones she intended to reject, despite the recitation of claims "218-230-248" at page 3 of the present Office Action

**VI. Rejection under 35 U.S.C. § 103**

Claims 92-230, 235-242, 245-248, 250, 251, 253, 256-259, 262, 263, 269, 273-275, 279-287 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Pavlin*. See pages 4-5 of the present Office Action. Applicants disagree and respectfully traverse this rejection.

As discussed above and as the Examiner and her supervisor agreed at the Interview on January 14, 2003, *Pavlin* fails to teach or suggest the at least one pasty fatty substance of the present invention.

Nevertheless, in order to facilitate prosecution and responsive to the Examiner's suggestion, the claims have been amended to recite that the at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature. Accordingly, Applicants respectfully request that the rejection under § 103(a) be withdrawn.

**VII. Conclusion**

In view of the foregoing remarks, Applicants respectfully request the reconsideration of the pending claims, reexamination of the application, and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 16, 2003

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## Appendix

Version with markings to show changes made pursuant to 37 C.F.R. § 1.121(c)(1)(ii):

Page 3, delete the first full paragraph, and substitute the following therefor:

-- To overcome at least one of these drawbacks, the inventors have envisaged replacing all or some of the waxes and/or fillers with at least one structuring polymer containing [contains] at least one heteroatom and at least one pasty fatty substance for structuring the liquid fatty phase. In particular, the inventors have discovered that loss in gloss of a stick comprising waxes is related to the anisotropic crystal structure of such waxes.--

Pages 25-26, delete the paragraph bridging these pages, and substitute the following therefor:

-- According to the present invention, the at least one pasty fatty substance may be chosen from hydrocarbon-based compounds, optionally of polymer type, silicone compounds and fluorinated compounds. In one embodiment, the hydrocarbon-based compounds contain ester groups. Of course, the at least one pasty fatty substance can also be a mixture of hydrocarbon-based and/or silicone and/or fluorinated compounds. In one embodiment, the at least one pasty fatty substance is a mixture of hydrocarbon-based and/or silicone and/or fluorinated compounds, wherein the hydrocarbon-based pasty fatty compounds are present in the composition in an amount greater than either the silicone pasty fatty compounds or the fluorinated pasty fatty compounds. In one embodiment, a mixture of pasty [past] fatty substances are used in which the pasty fatty substances are predominantly hydrocarbon-based pasty [past] fatty substances.

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IN THE CLAIMS:

Please replace claims 38, 39, 40, 129, 130, 131, 185, 214, 219, 251, 279, 280, and 281 as follows:

--1. (Amended) An anhydrous composition comprising at least one liquid fatty phase which comprises:

- (i) at least one structuring polymer comprising:  
a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and
- (ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

38. (Amended) The anhydrous composition according to claim 30, wherein in said formula (I), R<sup>3</sup>, which are [can be] identical or different, are each chosen from C<sub>2</sub> to C<sub>36</sub> hydrocarbon-based groups and polyoxyalkylene groups.

39. (Amended) The anhydrous composition according to claim 38, wherein R<sup>3</sup>, which are [can be] identical or different, are each chosen from C<sub>2</sub> to C<sub>12</sub> hydrocarbon-based groups.

40. (Amended) The anhydrous composition according to claim 39, wherein in said formula (I), R<sup>4</sup>, which are [can be] identical or different, are each chosen from hydrogen atoms.

92. (Amended) A composition comprising at least one liquid fatty phase which comprises:

- (i) at least one structuring polymer comprising:

a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and

(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

129. (Amended) The composition according to claim 121, wherein in said formula (I), R<sup>3</sup>, which are [can be]identical or different, are each chosen from C<sub>2</sub> to C<sub>36</sub> hydrocarbon-based groups and polyoxyalkylene groups.

130. (Amended) The composition according to claim 129, wherein R<sup>3</sup>, which are [can be]identical or different, are each chosen from C<sub>2</sub> to C<sub>12</sub> hydrocarbon-based groups.

131. (Amended) The composition according to claim 130, wherein in said formula (I), R<sup>4</sup>, which are [can be] identical or different, are each chosen from hydrogen atoms.

185. (Amended) A [An] composition comprising at least one liquid fatty phase which comprises:

(i) at least one structuring polymer, wherein said at least one structuring polymer is at least one polyamide polymer comprising:

a polymer skeleton which comprises at least one amide repeating unit; and

(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

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214. (Amended) The composition according to claim 210, wherein said silicone fatty substances are chosen from polydimethylsiloxanes [(PDMS)] having at least one pendant chain chosen from alkyl and alkoxy chains containing from 8 to 24 carbon atoms.

218. (Amended) A mascara, an eyeliner, a foundation, a lipstick, a make-up-removing product, a make-up product for the body, a nail composition, an eyeshadow, a face powder, a concealer product, a shampoo, a conditioner, an antisun product or a care product for the lips, face, body, or hair comprising a composition comprising at least one liquid fatty phase in said mascara, eyeliner, foundation, lipstick, blusher, make-up-removing product, make-up product for the body, nail composition, eyeshadow, face powder, concealer product, shampoo, conditioner, antisun product or care product for the lips, face, body, or hair which comprises:

(i) at least one structuring polymer comprising:

a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and

(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

219. (Amended) A deodorant product or a care product for the skin or body comprising a [an] composition comprising at least one liquid fatty phase in said product which comprises:

(i) at least one structuring polymer comprising:

a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and

(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

220. (Amended) A care and/or treatment and/or make-up composition for keratin materials comprising an anhydrous composition comprising at least one liquid fatty phase which comprises:

(i) at least one structuring polymer comprising:  
a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and  
(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

221. (Amended) A care and/or treatment and/or make-up composition for keratinous fibers, lips or skin comprising at least one liquid fatty phase in said care and/or treatment and/or make-up composition for keratinous fibers, lips or skin which comprises:

(i) at least one structuring polymer comprising:  
a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and

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(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

222. (Amended) A lipstick composition in stick form comprising at least one continuous liquid fatty phase, at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature, and at least one structuring polymer having a weight-average molecular mass of less than 100 000, said at least one structuring polymer comprising:

a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom.

223. (Amended) A method for care, make-up or treatment of keratin materials comprising applying to said keratin materials a composition comprising at least one liquid fatty phase which comprises:

(i) at least one structuring polymer comprising:

a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and

(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

224. (Amended) A method for care, make-up or treatment of keratinous fibers, lips, or skin comprising applying to said keratinous fibers, lips, or skin a composition comprising at least one liquid fatty phase which comprises:

(i) at least one structuring polymer comprising:  
a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and  
(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

225. (Amended) A method for providing a composition having at least one property chosen from a solid appearance, non-exudation, shear-strength, gloss, and comfortable deposit on keratin materials chosen from lips, skin, and keratinous fibers, comprising including in said composition at least one liquid fatty phase which comprises:

(i) at least one structuring polymer comprising:  
a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and  
(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

226. (Amended) A structured composition comprising at least one liquid fatty phase structured with at least one structuring polymer, wherein said at least one structuring polymer is at least one polyamide polymer comprising a polymer skeleton which comprises at least one amide repeating unit, wherein the at least one structuring polymer further comprises at least one chain chosen from

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(i) terminal fatty chains, optionally functionalized, chosen from alkyl and alkenyl chains, bonded to the polymer skeleton via at least one linking group chosen from amides, ureas, and esters, and

(ii) pendant fatty chains, optionally functionalized, chosen from alkyl and alkenyl chains, bonded to the polymer skeleton via at least one linking group chosen from amides, ureas, and esters,

wherein when said at least one linking group is chosen from esters, said at least one terminal fatty chain is chosen from branched alkyl groups, and

further comprising at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

227. (Amended) A structured composition comprising at least one liquid fatty phase structured with at least one structuring polymer comprising a polymer skeleton comprising at least one hydrocarbon-based repeating unit comprising at least one hetero atom, wherein the at least one structuring polymer further comprises at least one chain chosen from

(i) terminal fatty chains, optionally functionalized, chosen from alkyl and alkenyl chains, bonded to the polymer skeleton via at least one linking group chosen from amides, ureas, and esters, and

(ii) pendant fatty chains, optionally functionalized, chosen from alkyl and alkenyl chains, bonded to the polymer skeleton via at least one linking group chosen from amides, ureas, and esters.

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wherein when said at least one linking group is chosen from esters, said at least one terminal fatty chain is chosen from branched alkyl groups, and further comprising at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

228. (Amended) A make up or care or treatment composition for the skin, the lips, or keratinous fibers comprising a structured composition comprising at least one liquid fatty phase structured with at least one structuring polymer comprising a polymer skeleton comprising at least one hydrocarbon-based repeating unit comprising at least one hetero atom, at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature, and at least one coloring agent.

229. (Amended) A method of making up or caring for skin, lips, or keratinous fibers comprising applying to said skin, lips, or keratinous fibers a structured composition comprising at least one liquid fatty phase structured with at least one structuring polymer comprising a polymer skeleton comprising at least one hydrocarbon-based repeating unit comprising at least one hetero atom and at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

230. (Amended) A composition comprising at least one liquid fatty phase which comprises:

(i) at least one structuring polymer comprising

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a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom with the proviso that said at least one hetero atom is not nitrogen; and

(ii) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.

251. (Amended) The [anhydrous] composition according to claim 195 [194], wherein said at least one amphiphilic compound comprises a lipophilic part linked to a polar part, wherein the polar part is a residue of a compound chosen from [ ]alcohols and polyols comprising from 1 to 12 hydroxyl groups, and [ ]polyoxyalkylenes comprising at least 2 oxyalkylene units, from 0 to 20 oxypropylene units, and from 0 to 20 oxyethylene units.

279. (Amended) The [anhydrous] composition according to claim 180, wherein said at least one coloring agent is present in a proportion of from 0.5% to 40% relative to the total weight of the composition.

280. (Amended) The [anhydrous] composition according to claim 279, wherein said at least one coloring agent is present in a proportion of from 5% to 30% relative to the total weight of the composition.

281. (Amended) The [anhydrous] composition according to claim 280, wherein said at least one coloring agent is present in a proportion of from 5% to 25% relative to the total weight of the composition.

282. (Amended) A method for conferring long wearing properties on a composition comprising:

(a) at least one structuring polymer comprising:

a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom and at least one of:  
at least one terminal fatty chain chosen from alkyl chains and alkenyl chains, optionally functionalized, wherein said at least one terminal fatty chain is bonded to said polymer skeleton via at least one linking group and wherein said at least one terminal fatty chain comprises from 12 to 120 carbon atoms; and

at least one pendant fatty chain chosen from alkyl chains and alkenyl chains, optionally functionalized, wherein said at least one pendant fatty chain is bonded to said polymer skeleton via at least one linking group and wherein said at least one terminal fatty chain comprises from 12 to 120 carbon atoms,

wherein in said at least one structuring polymer, the percentage of the total number of fatty chains ranges from 40% to 98% relative to the total number of all repeating units and fatty chains in the at least one structuring polymer; and

(b) at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.--

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